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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/294,475	04/20/1999	KEVIN GATESMAN	WMA-99-001	6166

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EXAMINER

NGUYEN, STEVEN H D

ART UNIT PAPER NUMBER

2665

DATE MAILED: 12/02/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/294,475

Applicant(s)

GATESMAN, KEVIN

Examiner

Steven HD Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-3, 6-7, 9-15, 17-18 and 20-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonnby (USP 6515996) in view of Itoi (USP 6456625).

Tonnby discloses (Figs 1-9 and col. 1, lines 5 to col. 10, lines 60) apparatus for enabling more than one communicative process to be carried on at the same time over a subscriber line comprising a network interface means for connecting to a circuit switched telephone network (Fig 8, Ref 70 for connecting to PSTN); a telephone interface means for connecting to at least one telephone, wherein the telephone interface means is adapted to patch a call from the one telephone to the circuit switched telephone network via the network interface means upon a determination that no data connection is established to the circuit switched telephone network

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(Fig 8, Ref 71 for establishing a telephone call via PSTN if PC does not established with a service provider); a computer interface means for connecting to at least one computer (Fig 8, Ref 74); and a routing means for selectively routing voice and data signals from said telephone and said computer to and from said circuit switched telephone network via said subscriber line (Fig 7, Ref 80); an analog telephone interface, which includes a ring generator, DTMF generator, and dial tone generator (Col 9, lines 12-29); routing means for apportioning the bandwidth of the subscriber line for selectively routing the packet for computer and telephone (the voice packet and data packet is simultaneously multiplexed into the subscriber line, Fig 7, Ref 80). However, Tonnby does not disclosed routing means for assigning internal network addresses to said telephone and said computer and routing the voice and data packets according to assigned internal network addresses. In the same field of endeavor, Itoi discloses ((Fig 1-14 and col. 1-22) a routing means for assigning the internal network addresses to a telephone and computer and routing the incoming and outgoing voice or data packet based on the internal network address (Fig 3b, Ref 320 used to give the local IP addresses to data terminal 314 and telephone 311, See col. 8, lines 40-56); a gateway means for packetizing a received voice signal from the telephone interface and depacketizing the received voice signals from routing means via PSTN (col. 9, lines 45-60 discloses a means for packetizing voice signal into a packet or depacketizing voice packet into voice signal); routing means including an address conversion and translation means for translating the respective internal network addresses of the telephone and computer to correspond with an external network address of the subscriber line assigned to communicate with the network and establishing respective connections between the external network address of the subscriber line and the internal addresses of the telephone and the computer so that both voice

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and data signals can be exchanged between the telephone and said computer connected to the said communication controller and devices communicatively connected to the network (Fig 3b, Ref 307); a voice circuit communicatively connected to said telephone and said routing means for receiving and converting digital voice signal routed from the routing means into analog voice signal for telephone and converting and feeding analog voice signals input from the telephone into digital voice signals for the routing means (Fig 3b, Ref 309) and mapping the telephone number compatible with PSTN to an internal address (Fig 4);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a routing means for assigning an internal network address to the devices coupling the interface as disclosed Itoi's system into Tonnby's system. The motivation would have been to increase the number of devices can access to the Internet.

4. Claims 4-5, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonnby in view of Itoi as applied to claims 1, 9 and 17 above, and further in view of Awadallah (USP 6449251).

Regarding claims 4-5, 16 and 19, Tonnby and Itoi fail to disclose the claimed invention. However, Awadallah disclose a method and apparatus for setting a priority to the voice and data packets wherein voice packet has a higher priority than the data packet (col. 1, lines 28-37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply an priority means for setting a priority of voice and data packet as disclosed by Awadallah's system into the telecommunication network of Tonnby and Itoi. The motivation would have been to reduce the latency for transmitting the voice packets.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tonnby in view of Itoi as applied to claim 1 above, and further in view of Szeliga (USP 6067353).

Regarding claim 8, Itoi fails to fully disclose the claimed invention. However, Tonnby discloses DTMF generator, ring generator, a visual indicator for message and an alert message for incoming call (Col. 5, lines 50-62 and Col 9, lines 12-29) and Szeliga discloses a visual call waiting indicator (Fig 3, Ref 28 and col. 4, lines 24-47).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a universal indicator to a subscriber and a visual call waiting indicator as disclosed by Szeliga into the system of Tonnby and Itoi in order to provide an indicator to a deaf person.

#### ***Response to Arguments***

6. Applicant's arguments filed 9/16/03 have been fully considered but they are not persuasive.

In response to pages 12-15, the applicant states that the Tonnby does not disclose a system and method for determining no data connection with a circuit switched network, patch a call to a circuit switched network as claims 1, 9, 17, 25 and 26. In reply, Tonnby discloses the switches for receiving a call setup from a telephone and determining if the modem does not connect with internet service provider via a circuit switched network, the switches will switch to a location so that the call can be routed to the circuit switched network (Fig 6 and 8, the CPU will determine what modes the modem is activate, active mode "data connection" or de-active mode "no data connection" in order to control the relay to switch the switches; if data

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connection has been established or not if not the CPU will control REF 77 and 75 to release the switches to a position to establish a connection between telephone and circuit switched network in order to send a call setup message to the circuit switched network).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Tonnby discloses a device for establishing a telephone via PSTN or internet by determining the device being connected to data network or not and if not routing the call via PSTN via the switches in the device by controlling the switches to switch to a position as showed in Fig 6 and Itoi discloses a device has a routing means for assigning internal network addresses to said telephone and said computer and routing the voice and data packets according to assigned internal network addresses. The motivation would have been to increase the number of devices can access to the Internet with less external assigned IP address.

In response to applicant's argument that the suggestion and motivation is incorrect, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

A handwritten signature in black ink, appearing to be 'Steven HD Nguyen', with a long horizontal line extending to the right.

Steven HD Nguyen  
Primary Examiner  
Art Unit 2665  
11/24/03